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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/955,510	09/18/2001	Matthew A. Hayduk	884.552US1	9786

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EXAMINER

RAMAKRISHNAIAH, MELUR

ART UNIT	PAPER NUMBER
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2614

DATE MAILED: 06/23/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/955,510	Applicant(s) HAYDUK, MATTHEW A.	
	Examiner Melur Ramakrishnaiah	Art Unit 2614	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 April 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,2,4,5,7-16 and 18-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-2, 4-5, 16, 18-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Obradovich et al. (US 6,542, 812) in view of Jones (US PAT: 6,411,891, filed 4-26-2000).

Regarding claim 13, Obradovich discloses a mobile element, comprising: a position monitoring module (119, fig. 1) capable of monitoring a position associated with the mobile element (col. 4 lines 34-44), a first memory (108, fig. 1) including first service preferences as shown in fig. 3, the memory capable of receiving second service preferences determined by the position (col. 4, line 64 – col. 5, line 46, col. 8 lines 30-38, col. 9 lines 35-55).

Obradovich differs from claim 13 in that he does not explicitly teach the following: comparator module communicatively coupled to the memory to compare the first and second service preferences.

However, Jones teaches the following: comparator module communicatively coupled to the memory to compare service preferences (col. 23 lines 49-57).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Obradovich's system to provide for the following: comparator module communicatively coupled to the memory to compare the first and

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second service preferences as this arrangement would facilitate to determine user preferences for further processing as taught by Jones, thus facilitating to implement user preferences.

Regarding claim 14, Obradovich further teaches the following: a global positioning receiver in (119, fig. 1) communicatively coupled to the position monitoring module (119, col. 3 lines 31-35).

3. Claims 1-2, 4-5, 7-12, 16, 20, 21-22, 24, 25, 26, are rejected under 35 U.S.C. 103(a) as being unpatentable over Obradovich et al. (US 6,542,812, Provisional application No. 60/160,326, filed on Oct. 19, 1999, hereinafter Obradovich) in view of Rautila et al. (US PAT: 6,549,625, filed 6-24-1999, hereinafter Rautila) and Jones

Regarding claims 1, Obradovich discloses an application execution system, comprising: a position monitoring module (119, fig. 1), a mobile element (120, fig. 1) associated with a position capable of being monitored by the position monitoring module (col. 3 lines 31-45, col. 4 lines 34-41), the mobile element having memory (108, fig. 1) including a set of user service preferences including a first service preference (figs. 3-4, col. 6, lines 8 -50), a service broadcaster (reads on 630, fig. 5) capable of being communicatively coupled to the mobile element (100, fig. 1) and broadcasting a second service preference to the mobile element, and wherein favorites corresponding to profile is downloaded to the memory (108) when the first and second service preferences are determined to be related by the comparator module (col. 9 lines 35-54; figs. 3, 7).

Regarding claim 16, Obradovich discloses an apparatus, comprising: a processor (103, fig. 1), a memory (119, fig. 1) coupled to the processor for receiving a position and

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first service preferences (fig. 3) associated with the mobile elements, a memory coupled to the processor including a second service preference (figs. 3-4, col. 6, lines 8-50) associated with the position, and an application associated with the second service preference associated with the position, a list of favorites associated with the second service preference, wherein the list of favorites is downloaded to the mobile element when the second service preference is determined by the mobile element to be related to a first service preference stored in the mobile element (col. 3 lines 31-55; col. 9 lines 35-55).

Regarding claim 20, Obradovich discloses a method of executing an application, comprising: determining a position of a mobile terminal (fig. 1), selecting a second service preference associated with an application according to the position and a first service preference retained in the mobile elements (figs. 3-4, col. 6, lines 8-50, col. 3 lines 31-45), wherein the list of favorites is downloaded to the mobile element (100, fig. 1) upon mobile element determining that the first service preference is related to a second service preference (col. 9 lines 35-55).

Regarding claim 25, Obradovich discloses computer readable medium having program instructions stored therein for implementing, when executed by a digital processing device, a method for executing an application, the method comprising: determining position of a mobile element, and selecting a second service preference associated with an application according to position and first service preference retained in the mobile element (col. 7 lines 3-41, col. 8 lines 30-59), wherein the list of favorites is

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downloaded to the mobile element (100, fig. 1) upon mobile element determining that the first service preference is related to a second service preference (col. 9 lines 35-55).

Obradovich differs from claims 1, 16, 20, and 25 in that he does not teach the following: downloading the application to the mobile element; a comparator module included in the mobile element to compare the first and second service preferences.

However, Rautila discloses method and system for connecting a mobile terminal to a database which teaches the following: downloading application to the memory for execution by the mobile element (col. 5 lines 30-38); and Jones teaches the following: comparator module communicatively coupled to the memory to compare service preferences (col. 23 lines 49-57).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Obradovich's system to provide for the following: downloading application to the memory for execution by the mobile element as this arrangement would provide one of the methods, among many possible methods, of providing application programs for the user to obtain information from servers as taught by Rautila; a comparator module included in the mobile element to compare the first and second service preferences as this arrangement would facilitate to determine user preferences for further processing as taught by Jones, thus facilitating to implement user preferences.

Regarding claims 2, 4-5, 7-12, 22, 24, Obradovich further teaches the following: position monitoring module includes a software program (implicit as the reference teaches GPS receiver 119 to determine position, fig. 1, col. 6 lines 36-42), a global

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positioning system receiver (119, fig. 1) communicatively coupled to the position monitoring module (col. 6 lines 34-44), mobile element includes memory (108, fig. 1), wherein the service broadcaster includes an application associated with second service preference (col. 8, line 30 – col. 9, line 55), mobile element comprises a cellular phone (col. 4 lines 34-44), second service preference comprises a hotel list file (215, fig. 3), plurality of list files related to the set of user preferences is broadcast to the mobile element (col. 8 lines 29-50), plurality of list files is formatted as a selection list (fig. 8, figs 13-14), wherein selection list includes a selected number of items determined by the position (col. 8 lines 34-38), storing the first service preference in the mobile element (fig. 3), wherein second service preference is hotel list file (215, fig. 3).

Regarding claim 7, Obradovich teaches the following: mobile element is a personal internet client (fig. 5 col. 7 lines 20-29).

Obradovich differs from claim 21 in that although Obradovich teaches the following: broadcasting a second service preference (from 630, second service corresponding to users adopted profile) to the mobile element (100, col. 9 lines 35-55); he does not teach the following: requesting broadcast of the application, and broadcasting the application to the mobile element for downloading and execution by the mobile element.

However, Rautila discloses method and system for connecting a mobile terminal to a database which teaches the following: downloading application to the memory for execution by the mobile element (col. 5 lines 30-38).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Obradovich's system to provide for the following: requesting broadcast of the application, and broadcasting the application to the mobile element for downloading and execution by the mobile element as this arrangement would provide one of the methods, among many possible methods, of providing application programs for the user to obtain information from servers as taught by Rautila

Obradovich differs from claim 26 in that although it discloses application required to browse information obtained based on user service preferences and user profiles (col. 5 lines 1-33, col. 8 lines 29-50 of '812), he does not explicitly teach the following: downloading application to the memory for execution by the mobile element.

However, Rautila discloses method and system for connecting a mobile terminal to a database which teaches the following: downloading application to the memory for execution by the mobile element (col. 5 lines 30-38).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Obradovich's system to provide for the following: downloading application to the memory for execution by the mobile element as this arrangement would provide one of the methods, among many possible methods, of providing application programs for the user to obtain information from servers as taught by Rautila

4. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Obradovich in view of Jones as applied to claim 13 above, and further in view of Rautila.

The combination differs from claim 15 in that in that although he discloses application required to browse information obtained based on user service preferences and user profiles (col. 5 lines 1-33, col. 8 lines 29-50 of), he does not explicitly teach the following: downloading application to the memory for execution by the mobile element.

However, Rautila discloses method and system for connecting a mobile terminal to a database which teaches the following: downloading application to the memory for execution by the mobile element (col. 5 lines 30-38).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify the combination to provide for the following: downloading application to the memory for execution by the mobile element as this arrangement would provide one of the methods, among many possible methods, of providing application programs for the user to obtain information from servers as taught by Rautila.

5. Claims 18-19, 23 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Obradovich in view of Rautila and Jones as applied to claims 16, 20, 25 above, and further in view of Masaki (EP 0883270 A1).

Regarding claim 18-19, 23 and 27, the combination does not teach the following: a memory for receiving a set of capabilities associated with the mobile element, wherein the application is not downloaded to the mobile element if the set of capabilities associated with the mobile element is not in accordance with set of application

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requirements associated with the application, sending a set of capabilities associated with the mobile element to the service broadcaster.

However, Masaki discloses distributed computing system which teaches the following: to provide a distributed computing system capable of providing, in a network environment with various terminals, an application service corresponding to processing capability of each terminal, a memory in (12, fig. 1) for receiving a set of capabilities associated with the communication terminals (col. 3 lines 51-56, figs. 12-13, col. 25 lines 31-41, col. 26 lines 27-56).

Thus, it would have been obvious to one of ordinary skill in the art at the time invention was made to modify Obradovich's system to provide for the following: a memory for receiving a set of capabilities associated with the mobile element, wherein the application is not downloaded to the mobile element if the set of capabilities associated with the mobile element is not in accordance with set of application requirements associated with the application, sending a set of capabilities associated with the mobile element to the service broadcaster as this arrangement would facilitate data transmission based on capability of the communication terminals connected to the data transmission system as taught by Masaki.

Response to Arguments

Applicant's arguments filed on 4-11-2006 have been fully considered but they are not persuasive.

103 Rejections of the Claims

Claims 13-14 were rejected under 35 USC j 103(a) as being unpatentable over

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Obradovich et al. (U.S. 6,542,812; hereinafter Obradovich) in view of Jones (U.S. 6,411,891; hereinafter Jones). Claims 1-2, 4-5, 7-12, 16, 20-22, and 24-26 were rejected under 35 USC 103(a) as being unpatentable over Obradovich in view of Rautila et al. (U.S. 6,549,625; hereinafter Rautila) and Jones. Claim 15 was rejected under 35 USC j 103(a) as being unpatentable over Obradovich in view of Jones and further in view of Rautila. Claims 18-19, 23, and 27 were rejected under 35 USC j 103(a) as being unpatentable over Obradovich in view of Rautila and Jones, and further in view of Masaki (EP 0883270 A1; hereinafter Masaki): Regarding rejection of independent claims 1, 13, 16, 20, 25 using the above references, Applicant argues that combining references does not teach all limitations and further states that "As admitted by the office, Obradovich does not disclose a mobile element having a "comparator module ... to compare ... related to second service preference" (claims 20, 25) as claimed by applicant". Applicant further argues that "it is respectfully submitted that Jones teaches mobile element that does not include any type of comparison for user preferences ... comparisons are conducted by at a user's computer that monitors mobile unit position ... not in the mobile unit) against myriad display and playback options". Regarding this, as stated in the office action dated 2-8-2006, Obradovich teaches a mobile element (fig. 1) and does not teach comparator module communicatively coupled to the memory to compare the first and second service preferences. However, Jones teaches a computer which can compare user preferences to provide required service (col. 23 lines 49-57), Therefore, the combination of Obradovich and Jones teaches the limitations claim 13 as set forth in the office action above.

Applicant further argues "it is respectfully submitted that the result of comparison has no effect whether or not application is downloaded. First because no application is downloaded to the personal computer ... Neither does Rautila or Masaki". Regarding this, Applicant is attempting to argue against references individually. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant further argues "since no combination of references provides all of the claimed elements, independent claims 1, 13, 16, 20, and 25 are nonobvious". Contrary to applicant interpretation of references used in the rejection, Obradovich teaches mobile element which provides services preferences to user (col. 4, line 64 – col. 5, line 46, col. 8 lines 30-38, col. 9 lines 35-55) and Rautila teaches downloading application to mobile element, and Jones teaches comparator for comparing user preferences to provide desired service. Therefore, the combination of Obradovich, Jones and Rautila teaches the limitations of independent claims 1, 13, 16, 20, and 25 and rejection of claims as being obvious over the cited references is maintained as set forth in the office action above.

Regarding rejection of the claims, Applicant argues that there is no motivation to combine the references. In this connection, Applicant states that Jones does not teach a mobile element comprising ... comparisons are conducted outside the mobile element. Thus there is no motivation to add such comparisons to Obradovich because

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comparisons would continue occur outside of the mobile element, while Obradovich maintains service preferences inside the mobile unit". Regarding this, Applicant is attempting to argue against individual references. As stated in the office action, dated 2-8-2006, Obradovich teaches a mobile element (fig. 1) and does not teach comparator module communicatively coupled to the memory to compare the first and second service preferences. However, Jones teaches a computer which can compare user preferences to provide required service (col. 23 lines 49-57), Therefore, the combination of Obradovich and Jones teaches the limitations claim 13 as set forth in the office action above.

Applicant further argues that "The office asserts that it would be obvious to combine Obradovich and Rautilla because "this arrangement would provide ... application programs for the user to obtain information from servers ...". And Jones ... thus there is no motivation to combine Obradovich with Rautilla, as such would render the apparatus inoperative. The addition of Jones does nothing to overcome the fact that Rautilla teaches away from the combination with Obradovich, and further, Jones does not account for downloading an application into the mobile unit memory based on comparison of preferences, as claimed by the Applicant in independent claims 1, 16, 20, and 25. Jones also teaches away from comparisons conducted inside the mobile unit, and therefore, provides no motivation for ... Nothing taught by Masaki overcomes the fact the both Rautilla and Jones teach away from the suggested combinations". ".

Regarding this, Applicant is attempting to argue against references individually. In response to applicant's arguments against the references individually, one cannot show

nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Applicant further argues that there is no reasonable expectation of success and further argues against individual references. Again and again Applicant is arguing against references individually. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

In light of this, Examiner has made prima-facie case of obvious rejection of applicant's claims and rejection of claims 1, 2, 4-5, 7-16, 18-27 is maintained.

6. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

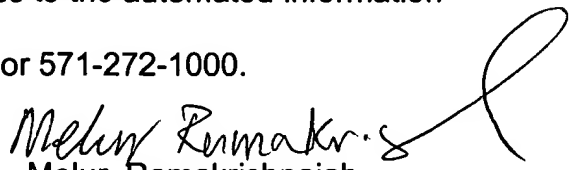
A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Melur Ramakrishnaiah whose telephone number is (571)272-8098. The examiner can normally be reached on 9 Hr schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Curt Kuntz can be reached on (571) 272-7499. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Melur Ramakrishnaiah
Primary Examiner
Art Unit 2614